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APR - 2 2004

APR - 7 2004

Paper No. 32

In re Application of  
 William P. Apps  
 Application No. 09/780,073  
 Filed: February 9, 2001  
 Attorney Docket No. RPC 0557 PUS

## DECISION ON PETITION

This is a decision on the petition filed by facsimile transmission on March 31, 2004 by which petitioner requests withdrawal of the examiner's holding that this application stands abandoned because the appeal has been dismissed due to the filing of an informal appeal brief. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

A review of the record shows that petitioner filed a substitute appeal brief on September 25, 2003 in response to the examiner's holding that the appeal brief filed on August 4, 2003 was defective in failing to satisfy all of the requirements of 37 CFR 1.192(c). The examiner has held the substitute appeal brief to be defective, and has, therefore, dismissed the appeal. As a result of the dismissal of the appeal, the examiner has held the application to have become abandoned because there are no allowed claim.

A review of the supplemental appeal brief shows that it is not defective as asserted by the examiner. On pages 5-6 of the supplemental appeal brief, petitioner has addressed the claims that are rejected as being anticipated by the Apps '925 patent and has stated that the claims that are rejected on that basis do not stand or fall together generally, but within those claims, has further indicated that certain claims do stand or fall together with certain other claims. Petitioner has provided arguments on pages 7-11 of the supplemental appeal brief in support of this position. That the examiner does not think that the arguments "are sufficient" is immaterial to compliance with the requirements of 37 CFR 1.192(c)(7) and 37 CFR 1.192(c)(8)(iii). The regulation requires presentation of arguments in support of the claim groupings, not presentation of arguments that the examiner finds either sufficient or persuasive.

As it appears that the examiner's action dated March 24, 2004 holding the supplemental appeal brief filed on September 25, 2003 to be defective was improper, it follows that the examiner's action in dismissing the appeal and holding the application abandoned was also improper. Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application will be forwarded to the Supervisory Patent Examiner in Art Unit 3727 to instruct the examiner to take immediate action on the supplemental appeal brief. Such action cannot be inconsistent with this Decision.

PETITION GRANTED.

  
 E. Rollins-Cross, Director  
 Technology Center 3700

Konstantine J. Diamond  
 4010 E. 26<sup>th</sup> Street  
 Los Angeles, CA 90023

EXHIBIT A  
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CHIEF SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
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In re Application of  
Gerald R. Koefeld et al  
Application No. 09/571,425  
Filed: May 15, 2000  
Attorney Docket No. RPC 0493 PUS

FEB 19 2003

DECISION ON PETITION

Paper No. 18

Date: 3-12-03

This is a decision on the petition filed on January 21, 2003 by which petitioners request supervisory review of the examiner's action regarding the appeal brief and examiner's answer in this application. The petition is considered pursuant to 37 CFR 1.181, and no fee is required. A refund of the \$130.00 petition fee tendered with the petition will be credited to Deposit Account No. 50-1984.

The petition is granted.

Appellants' brief on appeal was timely filed on October 25, 2002. The examiner felt that the appeal brief did not adequately address the matter of which claims on appeal stood together and which did not as required by 37 CFR 37 CFR 1.192(c)(7 and 8) and as discussed at MPEP § 1206. The examiner then promulgated an examiner's answer in which it is declared that all of the appealed claims "stand or fall together."

A review of the appeal brief shows that there is some ambiguity if the "Grouping of Claims" section on page 3 of the appeal brief is read literally and without reference to the arguments presented later in the appeal brief. However, it was improper for the examiner to take the action that he did. As discussed in MPEP § 1206, 37 CFR 1.192(d) states, *inter alia*,

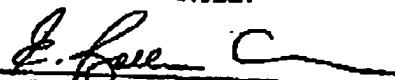
"If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a period of one month with which to file an amended brief." (Emphasis supplied.)

Given that the appeal brief is, at worst, ambiguous on the matter of claims standing or falling together, the examiner should have prepared form PTOL-462, "Notification of Non-Compliance With 37 CFR 1.192(c)", explaining the deficiency and offering appellant the one month period of time to correct the problem.

Accordingly, the examiner's answer dated November 14, 2002, paper No. 15, is hereby VACATED. Therefore, the reply brief attached to the instant petition will not be entered. Petitioners are given a period of ONE MONTH or THIRTY DAYS from the mailing date of this Decision, whichever is longer, in which to file a corrected appeal brief in triplicate. This period may be extended pursuant to 37 CFR 1.136. Failure to timely file the corrected appeal brief in triplicate will result in dismissal of the appeal. After the corrected appeal brief is filed, the examiner will treat this application as special and prepare an examiner's answer addressing the corrected appeal brief, or take such other action as may be appropriate.

The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3727 who should see that the above mentioned refund is made.

PETITION GRANTED.

  
E. Rollins-Cross, Director, Patent  
Examining Groups 3710 and 3720

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SOUTHFIELD, MI 48075

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Paper No. 12

In re Application of  
 William Apps *et al*  
 Application No. 09/977,636  
 Filed: September 15, 2001  
 Attorney Docket No. RPC 0554 PUS

## DECISION ON PETITION

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OCT 14 2003

This is a decision on the petition originally filed by facsimile transmission on August 27, 2003 and subsequently resubmitted. The duplicate submission has been discarded, see 37 CFR 1.4(b). In the petition, petitioners request withdrawal of the holding that this application stands abandoned for failure to timely file a reply to the Office letter dated August 16, 2002. No fee is required for the petition.

The petition is granted.

Petitioner alleges that the application is not abandoned because a reply to the Office letter in question was in fact filed, together with the appropriate petition for a three month extension of time and the fee therefor. The reply and extension are in fact of record in the file, and bear a filing date of March 4, 2003 and a 37 CFR 1.8(a) certificate of mailing dated February 19, 2003. As February 17, 2003 was a holiday in the District of Columbia, and as the Office was closed on February 18, 2003 due to a snow emergency, the reply and extension were in fact filed on the next available business day after the due date of February 16, 2003 and were timely filed. Therefore, it is clear that the application is not in fact abandoned.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3727 who will insure that the examiner takes the application up for action as the next application acted upon.

PETITION GRANTED.

*E. Rollins-Cross*

E. Rollins-Cross, Director, Patent  
 Examining Groups 3710 and 3720

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EXHIBIT A  
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